

REMARKS

Claims 1-2 and 4-8 remain pending in the above-identified application, and stand ready for further action on the merits. Claim 3 has been previously cancelled.

The instant amendment to the specification simply corrects an inadvertent typographical error and does not incorporate new matter into the application as filed. Support for the amendment occurs in Figures 1-2 of the application as originally filed.

The amendments made herein to claims 1, 4, 5 and 8 do not incorporate new matter into the application as originally filed, and are made primarily for purposes of clarity, and thereby alleviate the Examiner's minor concerns regarding earlier language recited in the claims.

Support for the instant claim amendments occurs in the original application as filed, including the original figures. For example, the amendments to claims 1, 4-5 and 8 find support in original Figures 1-3, and throughout the original specification (*e.g., see page 4, lines 13-16 and 27-29; page 9, lines 22-26; page 10, lines 20-23*).

Even though the current office action is a final office action, consideration of the instant amendment is entirely proper under the provisions of 37 CFR § 1.116, inasmuch as it serves to remove issues outstanding, does not raise any substantial new issues for the Examiner's consideration and at the same time serves to place the claims into better format for consideration by the USPTO Board of Patent Appeals, should the Examiner unexpectedly not find the present claims allowable. Accordingly, entry of the instant amendment is respectfully requested.

Specification Objection

At pages 2-3 of the office action, the Examiner objects to the disclosure purportedly due to several informalities, but then notes no actual informalities. Instead, the Examiner simply discusses claim limitations vis-à-vis the original disclosure, and sets forth a plethora of questions that add very little substance or meaning to the patentability issues remaining unresolved at present.

Moreover, the Examiner's comments and contentions regarding the "disclosure objection" are submitted to be the product of an eccentric application of USPTO Examination criteria, which has the ultimate effect of needlessly prolonging prosecution of a completely described and properly claimed invention.

For example, the Examiner questions how previous amendments at lines 14-15 of claim 1 correspond to arguments set forth at pages 11-12 of the prior reply and page 9, lines 17-26 of the specification. However, there is no noticeable contradiction within or between the noted sections, and no ambiguity or indefiniteness is otherwise raised by such sections (which a simple review of the same sections easily shows), and as such applicants fail to understand why such questions are being asked, since they do not relate to any actual or real informality in the disclosure, or provide any basis or support for a "disclosure objection".

Accordingly, the Examiner is respectfully requested to reevaluate her position (and thus the USPTO's position) on the current application's disclosure. Thereafter, if a "disclosure objection" is to be further maintained, the Examiner is requested to more clearly and particularly specify — an actual "informality" existing in the specification. It is Applicant's contention that no such informality exists.

Claim Objection

Claims 1-4 have been objected to based on an informality. The informalities noted by the Examiner have been noted and corrected. Withdraw of the claim objection is therefore submitted to be proper at present.

Claim Rejections – 35 USC § 112, Second Paragraph

Claims 1-4 have been rejected under the provisions of 35 USC § 112, second paragraph, as being indefinite for failing to particularly and distinctly claim the subject matter, which applicants regard as their invention. Reconsideration and withdraw of this rejection is respectfully requested based on the following consideration.

As stated in M.P.E.P. §§ 2173.01 and 2173.02 :

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the

claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

The claims as instantly amended clearly and distinctly set forth the invention that the applicants regard as their own. The Statute requires no more. In this respect, each of the terms used in the currently amended claims has proper antecedent basis, including those terms mentioned in the outstanding office action by the Examiner.

Claim Rejections – 35 USC § 112, First Paragraph

Claim 4 is rejected under the provisions of 35 USC § 112, first paragraph as failing to comply with the written description requirement. Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

In support of the rejection, the examiner points to language in claim 4 concerning a “cuff”, however, no such language occurs in claim 4 and a “cuff” is never mentioned in claim 4. In this regard, the curved leg elastic members recited in claim 4 are clearly shown in Figures 2-3 as item

91. The curved leg elastic members recited in claim 4 are not part of the cuff, and should not be confused with the cuff elastic members 61 shown in Figure 2.

Further to the above, the instant specification, in the paragraph bridging pages 8-9, clearly teaches as follows regarding the curved leg elastic members.

Since the pair of leg elastic members 9 and 9 are disposed in inward curves, the disposable diaper 1 is prevented effectively from sliding down while in use. Since the leg gathers fit the legs easily, the disposable diaper 1 can easily be put on a wearer whether the wearer is standing or lying. In particular, because the under-waist elastic member 8 is disposed in an area nearer to the middle in the width direction of the diaper than the end 91 of the leg elastic member 9 positioned in the rear portion A as shown in FIG. 2, the leg opening portion is extended outward together with the outward extension of the under-waist portion E in fitting the diaper 1. As a result, the leg opening portion can be fitted in place easily and in a wearer-friendly manner even when an infant is kicking and struggling to get free. If the under-waist elastic member is disposed only in the area farther than the end of the leg elastic member from the middle of the diaper width as in the disposable diapers disclosed in JP-W-9-507409 and JP-A-6-63077, the leg opening portion having the leg elastic member is not extended in fitting the diaper.

Claim Language Interpretation

The US PTO's comments at paragraph "5." of the office action do not affect the literal scope of the pending claims and/or limit the equivalents that are protected and encompassed thereby.

Further, reconsideration of such comments is required, due to the instant amendment to the claims, which renders many of the Examiner's comments moot or inapplicable to the currently amended claims (*e.g.*, see instant amended claims 1, 4-5 and 8).

Claim Rejections Under 35 USC § 102(b) and 103(a)

Claims 1-3 and 5-8 have been rejected under 35 USC § 102(b) as being anticipated by ***Clear et al. US '584*** (US 5,368,584) and thereby ***Buell et al. US '274*** (US 5,221,274).

Claim 4 has been rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over ***Clear et al. US '584*** and thereby ***Buell et al. US '274*** and ***Lawson '278*** (US 4,695,278).

Reconsideration and withdraw of each of these rejections is respectfully requested based on the amendments made herein to the claims and the following remarks.

First, it is noted that claim 3 was cancelled in the prior reply of December 20, 2005, so that the Examiner's rejection of claim 3 is improper.

Incorporation of Earlier Remarks by Reference

The instant rejection is maintained from a prior office action. As such, comments set forth in the Inventors prior replies of April 29, 2005 and December 20, 2005 responding to very similar rejections are incorporated herein by reference in their entirety, since such comments remain cogently relevant to a consideration of the patentability of the instantly pending claims 1-8. In particular, the Examiner's attention is directed to page 8, line 7 to page 21, line 10 of said prior reply of April 29, 2005 and pages 8-21 of the reply of December 20, 2005.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61

USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Distinctions over the Cited Art

In the cited art references, a large sheet of the elastic member is arranged so that it extends from a waist portion to an under-waist portion, thereby covering two portions. This structure gives disadvantages, inasmuch as the contractibility of the references' waist portions and the under-waist portions are *manifested together and operate dependently*.

Accordingly, the cited references provide no teaching or other disclosure that provides for a diaper as instantly claimed wherein one can effectively differentiate the extension stress of a waist opening portion from that of an under-waist portion. Such references also fail to provide any motivation to those skilled in the art that would allow them to arrive at or otherwise produce a diaper as instantly claimed wherein one can effectively differentiate the extension stress of a waist opening portion from that of an under-waist portion.

In support of the above considerations, the Examiner's attention is directed to instant amended claim 1, wherein it is clearly recited:

1. A disposable diaper which has a substantially elongate configuration and comprises a main body having a pair of side edges, and the main body having a liquid-permeable topsheet, a liquid-impermeable backsheet, a liquid-retentive absorbent member interposed between said topsheet and said backsheet and a pair of fastening tapes provided on respective side edges of said main body,

a waist opening portion and an under-waist portion being present in a portion of the diaper, with the under-waist portion having said fastening tapes

directly attached thereto, the waist opening portion being provided with a continuous waist elastic member arranged in an extended state in a width direction of the diaper, and the under-waist portion being positioned right below the waist opening portion and being provided with a plurality of under-waist elastic members in the width direction of the diaper, which are separate from the continuous waist elastic member, and

a pair of longer side portions of said diaper each being provided with a sheet forming an upright cuff and said pair of longer side portions further containing leg elastic members,

wherein the continuous waist elastic member and the plurality of under-waist elastic members do not touch each other,

wherein said under-waist elastic members are fixedly disposed in at least areas extending outwardly from each longer side of the absorbent member in their stretched state, while the liquid-permeable topsheet or the liquid-impermeable backsheet or the sheet forming one of the upright cuffs are expanded in a plane, so as to manifest contractibility,

wherein said under-waist elastic members are not disposed in at least a middle portion of said under-waist portion where a portion of said absorbent member exists, and said under-waist portion having said fastening tapes has a greater extension stress in a width direction of the diaper than said waist opening portion,

wherein said under-waist elastic members are fixed between the sheet forming one of the upright cuffs and the liquid-impermeable backsheet, and

wherein a portion of said diaper that is (i) at an opposite end of said diaper from said pair of fastening tapes provided on said respective side edges of said main body, and (ii) across a crotch portion of said diaper from said pair of fastening tapes provided on said respective side edges of said main body, contains a second waist opening portion being provided with a continuous waist elastic member arranged in an extended state in a width direction of the diaper, with no elastic members being arranged in a width direction of said diaper in a portion of the diaper extending in between said crotch portion and said second waist opening portion of said diaper. (emphasis added)

Based on the above considerations, withdraw of the outstanding rejection of claims 1-2 and 4-8 is entirely proper at present.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims 1-2 and 4-8 are allowed and patentable under the provisions of Title 35 of the United States Code.

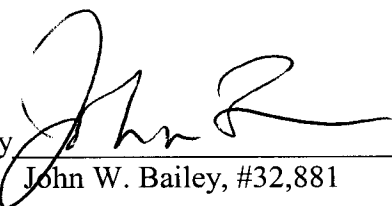
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) to expedite prosecution in connection with the present application towards allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
John W. Bailey, #32,881

JWB/jwb
0445-0315P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000